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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,180	09/20/2001	Makarand P. Gore	10012215-1	4586

7590 03/14/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

ACKUN, JACOB K

ART UNIT PAPER NUMBER

3723

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

Office Action Summary	Application No.		Applicant(s)	
	09/960,180		GORE ET AL.	
	Examiner		Art Unit	
	Jacob K. Ackun Jr.		3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claims 1-19 the claims are indefinite because it is not clear whether the applicant intends to claim only the subcombination of the protective container or the combination of the protective container and material contained therein. This in turn is because portions of the claims indicate that what is claimed is the subcombination (note line 1 of claim 1 for example only), while other portions indicate that what is claimed is the combination (note the last line of claim 1 for example only, wherein the preventative agent is further expressly limited by reference to the material. In another example only note the express limitations on the material in dependent claims 5 and 6 to colored and etiological materials respectively). Note in another example the selection of preventative agent required in claim 3. Clarification of the scope of the claims is required. For example only, if it is the applicant's intention to claim the combination then line 1 of each of the product claims should clearly so indicate. In this office action it is presumed that the product claims are drawn to the subcombination of the container only, in order to give the claims their broadest reasonable interpretation per the applicable Rules. Accordingly all references in the claims to any material are considered only as statements of intended use with regard to the claimed container. Moreover since no product claim structurally requires any material no reference applied in a rejection against any product claim is required to show any material (or to show any structural relationship between the container and such material as set

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forth in the claims at bar). Any such material taught in a reference so applied against any of the product claims is merely coincidental.

3. Claims 1-20 are finally rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Simon (4,880,119). The reference discloses a protective container consisting essentially of a durable outer casing, an inner casing and preventative agent as recited in the claims. In the embodiments wherein the inner casing is constructed of glass or plastic, the inner casing is considered to be less durable than the outer casing which is taught to be constructed of metal. However, in the alternative, it would have been obvious to construct the inner casing to be less durable than the outer casing in order to facilitate the construction of a more cost effective container, especially given the presence of the preventative agent 24. the inner and outer casings 14 and 10 respectively are considered to be coupled together since they are held together in such a way that they are not free to be separated by chance.

4. Claims 1-20 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Haigh et al (3,999,653 cited by the applicant). The claimed inner casing reads on bottle 12 and the claimed outer casing reads on portions of the package external to the inner casing, such as the outer wall of jacket 17 and/or outer jacket 26 and/or packaging 72, 73, 75 and 76 in the embodiment of Fig 8. In the embodiment of Fig 1, the inner casing is considered to be less durable than the outer casing since the inner casing broke when impacted by the hammer while the outer casing was intact (note the description in column 8 lines 27+). The inner casing of Haigh is considered to be coupled to the outer casing.

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5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacıkyan (6,530,472). Hacıkyan discloses most of the elements of the claims, but may not disclose the claimed difference in durability between the outer and inner containers. Structures such as lining 112, for example only, satisfy the requirement for an inner container and absorbent layer 110 meets the requirement for the preventative agent. It would have been obvious to construct the device of Hacıkyan from materials such that the inner casing was less durable than the outer casing, as a design expedient, or in order to provide a more cost effective container, for example, depending on the particular substance to be placed in the inner casing.

6. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kreutz et al (4,213,528), Shantz et al (4,948,642) and Hacıkyan (5,984,087). With regard to Kreutz inner container 15 is considered to be less durable than outer container 11, since unlike the outer container, the inner container could shatter or break. With regard to Shantz the inner container is the inner layer and the outer container the outer layer. Note the disclosed materials for the “less durable” requirement. Similarly, the inner container 30 of Hacıkyan is considered to be less durable than the outer container (in this case the outer container can be the outer layer 12 constructed of wood or plastic as taught in the reference). In all cases the inner and outer casings are considered to be coupled together.

7. Applicant's arguments filed on 11/26/2004 have been fully considered but they are not persuasive. However, it may be noted that 35 USC 112 first paragraph rejection has been withdrawn based on the the applicants' remarks regarding this ground of rejection. On the other hand the applicants' comment at the beginning of the last paragraph of page 8 is not entirely clear. The rejection for New Matter does not depend on what Amendment the New Matter was

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contained in. it would appear that any change in the claims not supported by the Disclosure as filed would be subject to this ground of rejection at least any time during prosecution. However, as already noted this ground of rejection, that was based on the language specifically identified in paragraph 2 lines 5 and 6 of the last office action, has been withdrawn. The remaining arguments made by applicants will now be addressed.

The rejection for indefiniteness has not been withdrawn. The applicants comments on the one hand to the effect that only the subcombination is claimed (see page 9 of the Remarks, last paragraph) are not convincing when compared with other comments of the applicants and the plain language of the claims. For example, in traversing the rejection over Hacikyan the applicants argue (and highlight) that that the claims require that the inner casing be in direct contact with the contained material. Based on this argument the applicants contend that the vial of Hacikyan must be analogized to be the inner casing as opposed to a structure such as the inner wall 112 in one embodiment. However, some material can clearly be inherently placed in the container of Hacikyan such that it contacts the inner wall. The applicants can not have it both ways. Either the content is not claimed and therefore can not be relied on structurally, or the content is claimed, in which case the applicants can be heard to argue that the reference does not teach the content or its structural interaction with the claimed container. In another example only, if the content is not claimed how is the examiner to interpret the limitation in claim 1 subpart b) subpart ii) wherein the inner casing is specified to be “uncreative to the material”. Does that not depend as much on the material as on the inner casing? Finally, as noted in the rejection itself see the other parts of the claims where the claimed protective container is structurally limited with respect to the material. In response to specific comments by applicants (note Remarks at page 9

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last paragraph) there is clearly a difference between recitations such as “configured to be a barrier” which is functional and does not raise issues of the type noted herein, and recitations such as noted above that do cause problems. Although “sufficient to” may not be as problematic depending on the interpretation, in light of the comments above it raises questions as noted, because it appears to require a quantity of preventative agent, a quantity that as claimed, depends on the contained material.

The argument that the applied references do not show the “coupled together” limitation is also unconvincing. In pointing out the support for such limitation in response to the New Matter rejection the applicants refer to one portion of the original Disclosure, page 8 lines 17-19. As noted by applicants this portion of the Disclosure reads in part that “in such a case the outer and inner casing are coupled together in some manner”. This appears to be the only teaching regarding the coupling together. With nothing more it would appear reasonable to indicate that the relevant structures in the references are coupled together in some manner even if configured as in Haigh or Simon, as opposed to wall structure such as the outer wall in Hacikyan. Why should the examiner withdraw the rejection based on the contention that the references do not teach the “coupled together” limitation, when the Disclosure is as vague as noted above as to what “coupled together” means?

As to the “consisting essentially of” terminology the examiner does not agree that it requires the interpretation noted by applicants. See MPEP 2111.03. It appears that the references applied in the last office action meet the noted limitation since the additional structures disclosed do not materially affect the basic and novel characteristics of the inventions. However, the

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reference to Simon is now applied in the event the noted terminology is later deemed to obviate the prior rejections.

As to Kreutz, Shantz and Hacikyan the examiner disagrees that they are less relevant than the prior references discussed, particularly in view of the comments above. For example, why should Shantz teach that the inner layer can act as a preventative agent for the reference to be applied against the claims? The indefiniteness rejection notwithstanding, the claims are interpreted as not requiring the container content or material. Note the comments in the rejections themselves. It is by now well settled that features not claimed may not be relied upon in support of patentability. It is sufficient where as here the examiner finds that the tie layer of Shantz is inherently capable of use as a preventative agent for some material for the reference to be applied against claims of the scope presented for examination in this application.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

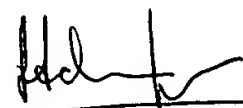
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob K. Ackun Jr. whose telephone number is (571)272-4418.

The examiner can normally be reached on Monday through Friday 8.30AM-5.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571)272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacob K. Ackun Jr.
Primary Examiner
Art Unit 3723

J.A.